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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,911	07/20/2001	Patricia M. Winegar	RAR314.02	9157

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EXAMINER	
CHIANG, JACK	

ART UNIT	PAPER NUMBER
2642	

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
09/909911	P. Winegar	
Examiner	Group Art Unit	#6
J. Chiang	2642	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 7-20-01.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above claim(s) 14, 17-27 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 15-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

RESRICTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-14, drawn to the combination of a headband and indicator, classified in class 381, subclass 377 or 378.

   II. Claims 15-20, drawn to the combination of ear hook and indicator, classified in class 381, subclass 381.

   III. Claims 21-27, drawn to the combination of microphone clip and indicator, classified in class 381, subclass 375.

2. The inventions are distinct, each from the other because:

   a. Inventions Groups I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions in which Group I requires a headband which is unrelated to ear hook in Group II, or the microphone clip in Group III.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

Each of the Groups (I, II, III) also contains different species as follows:

Group I, Claims 1-14, contains:

Specie 1, claims 3, 12, indicator on upward end;

Specie 2, claims 4, 13, indicator is inside;

Specie 3, claims 5, 14, adjustable extension;

Specie 4, claim 6, the extension is connected to the headband;

Specie 5, claim 7, the extension is on the earpiece;

Specie 8, claim 8, the extension is on the boom;

Specie 9, claim 9, fiber optic;

Specie 10, claim 10, LED.

In Group I, claims 1-2, 11 are generic.

Group II, claims 15-20, contains:

Specie 1, claim 16, the extension is on the ear hook;

Specie 2, claim 17, the extension is on the earpiece;

Specie 3, claim 18, indicator on upward end;

Specie 4, claim 19, indicator inside;

Specie 5, claim 20, adjustable extension.

In Group II, claim 15 is generic.

Group III, claims 21-27, contains:

Specie 1, claim 22, the light is in the microphone;

Specie 2, claim 23, the light is on the clip;

Specie 3, claims 24-25, extension on the microphone;

Specie 4, claim 26-27, extension on the clip.

In Group III, claim 21 is generic.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. A telephone call was made to Mr. Richard A. Ryan on 3-16-04 and 3-18-04 to request an oral election to the above restriction requirement, Mr. Ryan has elected Specie 1 in Group II, therefore, claims 15-16 are examined, and claims 1-14, 17-27 are withdrawn from further consideration.

CLAIMS

Art Rejection

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Such (US 5457751).

Regarding claim 15, Such shows:

An ear hook (see 15 in fig. 7);

An earpiece (40, col. 7, lines 66-67);

A boom and its microphone (40', col. 7, lines 66-67);

Ab extension member having a light source (see 12', 13) electrically connected to the phone unit for indicating when the phone is in an off-hook condition (i.e. screen 13 is on).

Regarding claim 16, the extension member (see 12', 13) is connected to the ear hook (15).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson (US 5608794) in view of Such.

Regarding claim 15, Larson shows:

An earpiece (16);

A boom and its microphone (18-19);

An extension member having a light source (23) electrically connected to the phone unit for indicating when the phone is in an off-hook condition.

Larson differs from the claimed invention in that it does not explicitly show an ear hook. However, it is commonly seen that headsets have ear hook, this is shown by Such. In Such, it shows an ear hook (15) and an extension member having a light source (12', 13).

Hence, the concept and function of having an extension member (fig. 2 in Larson) is well taught by Larson, it would have been obvious for one skilled in the art to modify Larson with an ear hook and the extension member as taught by Such, because ear hook is a common feature in headset, in which it re-enforce the supporting function in the headset when it is mounted on the ear of the user.

Regarding claim 16, the combination of Larson and Such shows the extension member (see 12', 13 in Such) is connected to the ear hook (15).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on 703-305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JACK CHIANG
PRIMARY EXAMINER